

Appl. No. 10/706,103
Docket No. 9118M2
Amdt. dated November 6, 2009
Reply to Office Action mailed on August 6, 2009
Customer No. 27752

REMARKS

Claim Status

Claims 1-4 and 8-17 are pending in the present application. Claims 5-7 have been previously canceled without prejudice.

Independent claims 1, 12, and 16 have been amended to limit the materials that may comprise the particulate retentive agent. Claim 14 has been amended so that it claims a method for treatment only.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §112, First Paragraph

The Office Action rejects claim 14 under 35 USC §112, first paragraph, for failing to comply with the written description. Specifically, the Office Action states that the term “preventing” is too broad and is not supported in the specification. While Applicants do not agree with the rejection, in order to further prosecution, Applicants have amended claim 14 as the Examiner has suggested and have deleted the term “preventing.” Applicants respectfully ask that the rejection be withdrawn.

Rejection Under 35 USC §102 by Kiyoshige (US 4,689,221)

The Office Action rejects claims 1-4, 8, and 10-17 under 35 USC §102 as being anticipated by Kiyoshige. Applicants respectfully traverse.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As understood, Kiyoshige discloses an oral composition that prevents periodontal disease, comprising an antibody and an abrasive in an orally acceptable carrier. But Kiyoshige fails to disclose any of the particulate retentive agents listed in

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Applicants' amended claims 1, 12, and 16. Because Kiyoshige does not expressly or inherently describe each and every element of the present claims, Applicants submit that Kiyoshige does not anticipate the present invention. Therefore, Applicants respectfully request that the rejection be withdrawn.

Rejection Under 35 USC §103(a) over Kiyoshige and Lawlor (US 6,706,256)

The Office Action rejects claims 1-4 and 8-17 over Kiyoshige and Lawlor. Applicants respectfully traverse.

To establish a *prima facie* case of obviousness under §103, the Examiner has the burden of showing, by reasoning or evidence, that: 1) there is some suggestion or motivation, either in the references themselves or in the knowledge available in the art, to modify that reference's teachings; 2) there is a reasonable expectation on the part of one of ordinary skill in the art that the modification or combination has a reasonable expectation of success; and 3) the prior art references (or references when combined) teach or suggest all the claim limitations. MPEP §2145. Applicants submit that the burden of a *prima facie* case of obviousness has not been met due to a failure of the prior art references teach or suggest all the claim limitations.

As discussed above, Kiyoshige fails to disclose any of the particulate retentive agents of the present invention, at any level. Lawlor fails to disclose any of the particulate retentive agents at the levels of the present claims. When Lawlor does disclose use of some of the present invention's retentive agents as teeth color modifiers, it discloses levels from about 0.05% to about 20%, most preferably from about 0.25% to about 10%. The present claims require from 35% to 65% of a particulate retentive agent, clearly a significant difference from Lawlor. As Lawlor does not teach or suggest a reason to at least double the amount of its teeth color modifiers (which is likely related to the fact that it does not teach or suggest that its compositions would or could stick in a subject's teeth for 5 to 60 minutes after chewing), Lawlor, and the combination of Kiyoshige and Lawlor, fail to teach or suggest all the claim limitations.

Therefore, a *prima facie* case of obviousness has not been established, and Applicants respectfully request that the rejection be withdrawn.

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Rejection Under 35 USC §103(a) Over Lawlor in view of Fine (US 4,374,822) et. al.

The Office Action rejects claims 1-4 and 8-17 under 35 USC §103(a) as being unpatentable over Lawlor (US 6,706,256) in view of Fine, et al. (US 4,374,822) as evident by Grossman et al. J. Dent. Res. 16(5), 409-416, 1937. Applicants traverse and respectfully argue that the cited references do not establish a *prima facie* case of obviousness.

Lawlor, as discussed above and in previous responses, does not disclose any of the claimed retentive agents at the levels used in the present invention. The Office Action confirms this by noting that Lawlor fails to teach the percentage of the retentive particulate as 35-65% (bottom of page 12), and continues that Fine is introduced to teach specific claimed retentive particulate agents. Applicants have amended claims 1, 12, and 16 to limit the materials that comprise the particulate retentive agent, and note that Fine does not disclose any of the presently claimed particulate retentive agents. Therefore, because the prior art references and the combination of the prior art references do not teach or suggest all the claim limitations, Applicants contend that the burden of establishing a *prima facie* case of obviousness has not been met. Applicants respectfully request that the rejection be withdrawn.

Conclusion

This response represents an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied references. In view of the foregoing, entry of the amendments presented herein, reconsideration of this application, and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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